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|--|-------------|----------------------|---------------------|------------------|
| 10/597,959   | 11/19/2007  | Mirko Danz           | DANZ-5              | 8461             |
| 20151 7590 11/27/2009<br>HENRY M FEIEREISEN, LLC<br>HENRY M FEIEREISEN<br>708 THIRD AVENUE<br>SUITE 1501<br>NEW YORK, NY 10017 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| RICK, JASON D  |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 2442   |             |                      |                     |                  |
| NOTIFICATION DATE  |             | DELIVERY MODE        |                     |                  |
| 11/27/2009   |             | ELECTRONIC           |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

INFO@FEIEREISENLLC.COM

# Office Action Summary

**Application No.**

10/597,959

**Applicant(s)**

DANZ ET AL.

**Examiner**

JASON RECEK

**Art Unit**

2442

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is in response to the amendment filed on August 3<sup>rd</sup> 2009.

#### ***Status of Claims***

Claims 9-16 are pending but rejected under 35 U.S.C. 103(a).

#### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Response to Arguments***

2. Examiner acknowledges and appreciates applicant's concise response to all the outstanding objections and rejections.
3. Applicant's arguments, see pg. 6, with respect to the drawings and specification have been fully considered and are persuasive. The objection of the drawings and specification has been withdrawn.
4. Applicant's arguments, see pg. 7-9, with respect to the rejection(s) of claim(s) 9-16 under 102/103 have been fully considered and are persuasive. Specifically, the

argument that Camerini does not disclose all the newly added limitations is persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Nakatani US 2003/0061384 A1.

5. It should also be noted that examiner does not agree with applicant's interpretation of Camerini. Applicant describes Camerini as a system in which a module knows its name and thus its functionality (pg. 8). This is not correct. Camerini clearly states that a name is assigned only for DHCP purposes, and does not predefine any functionality of the module (paragraphs 18-23).

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camerini et al. US 2002/0046263 A1 in view of Nakatani US 2003/0061384 A1.

Regarding claim 9, Camerini discloses "a method for installation of an automation component" as a method of configuring an automation module (abstract), "request of a

communication address", "sending a communication address" and activating the communication address" (paragraph 7);

"requesting by the automation component from the server a first configuration data record identifying a functionality of the automation component" clients queries server for configuration data (paragraphs 24-25).

Camerini does not explicitly disclose "requesting ... a second configuration data record" or "carrying out a process in accordance with the second configuration data record" however this is taught by Nakatani as a device requesting updated/new configuration information (i.e. second configuration data), and providing the device with such information (paragraphs 54-55). Nakatani clearly teaches this is "second configuration data" because the device has already been identified and its functionality determined (paragraph 52).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Camerini with the teachings of Nakatani for the purpose of configuring a device. Camerini teaches a device that makes multiple configuration requests for updating (i.e. second configuration) its configuration data (paragraph 26). Nakatani makes it explicitly clear that a unknown device is first identified (paragraph 52) and then a second configuration request occurs (paragraph 54). Nakatani suggests that by doing so dynamic configuration is possible (paragraph 9).

Regarding claim 10, Camerini discloses "enable reception ... without interfering with an ongoing communication" as addressing via DHCP does not disrupt ongoing communications (paragraph 21).

Regarding claim 11, Camerini discloses "the server is a DHCP server" and "an IP address" (paragraph 7).

Regarding claim 12, Camerini does not explicitly disclose "send an MAC address" however it does teach that this can be done in order to retrieve an IP address (paragraph 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Camerini to use a MAC address. Such a scheme is well known in the art and yields predictable results as described by Camerini.

Regarding claims 13-16, they are system claims that correspond to the method of claims 9-12, therefore they are rejected for similar reasons.

### ***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dinges et al. US 7,370,084 B2 discloses configuring and accessing a plurality of automation components (abstract).

Stawikowski et al. US 7,366,752 B2 discloses configuring a remote device using SOAP (abstract).

Ruutu et al. US 2005/0131551 A1 discloses a system for controlling automation modules (abstract).

Ogawa et al. US 2004/0218591 A1 discloses configuring an automation device based on received configuration information (abstract).

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON RECEK whose telephone number is (571)270-1975. The examiner can normally be reached on Mon - Fri 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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